

REMARKS/ARGUMENT

Claims 1-15 are pending in this application. Claims 1-15 stand rejected. By this Amendment, Applicant has added new claims 16 and 17. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1, 3-13 and 15 stand rejected under 35 USC § 103(a) as being unpatentable over Landsman et al., U.S. Patent No. 6,516,338 B1 in view of Hotscripts. Applicant respectfully requests reconsideration and withdrawal of the pending rejection.

Landsman teaches a technique for dynamic advertising in a network based client/server environment. The technique includes downloading of advertisements from an advertising server to a browser, and subsequently displaying the advertisements, on an interstitial basis, in response to a click stream generated by the user. To implement the technique, an advertising tag is embedded in the HTML code of a web page.

The advertising tag contains two components. The first component is a reference to a JavaScript file, which, when downloaded and executed by a browser, dynamically writes a combination of applet tags that collectively form a Transition Sensor applet. The Transition Sensor applet performs various functions, which among other things, initiates the download of an AdController applet. Both The JavaScript file and the AdController applet are stored at a distribution server. See, Col. 11, lns. 32-43.

The second component of the ad tag is a URL reference for a particular Ad Management System (“AMS”). The AMS is typically a third

party advertising server containing specific media. The specific media includes advertisements and accompanying player files.

When a user requests a web page that includes an ad tag, the browser executes the JavaScript file referenced in the ad tag, which invokes the dynamic writing of the Transition Sensor applet. The Transition Sensor applet is then executed and, among other functions, communicates the URL reference of the AMS included in the ad tag to the AdController, which in turn would download advertisements from the AMS.

In short, Landsman teaches an ad tag including a reference to both a JavaScript file, and the URL of an ad server.

In contrast, Each of Applicant's independent claims require an ad tag with a reference to a JavaScript file, where the JavaScript file further includes a reference to the ad server. As recognized in the Office Action, Landsman fails to teach a JavaScript file including a reference to the ad server. See, Office Action at 3. In an attempt to cure this deficiency, the Office Action asserts that an ordinary skill in the art would modify Landsman using HotScripts by placing the reference to the ad server in the JavaScript file "since JavaScript is a language that was well known used [sic] to extend the capabilities of HTML." Office Action at 4. Additionally, in response to Applicant's previous arguments, the Office Action asserts that the reference to the advertising server would be included in the file downloaded from the first server "[s]ince this file is needed anyway for the system to run..." Office Action at 12-13. Finally, the Office Action asserts that "any [one] of ordinary skill in the art would have modified Landsman and HotScripts to derive what is claimed by Applicants." Office Action at 13. Applicant respectfully asserts

that the Office Action has failed to establish a motivation to combine the cited references.

The Office Action has failed to show a motivation in the cited references for modifying Landsman's ad tag having a reference to a JavaScript file and a reference to an ad server, in light of HotScripts, which teaches a JavaScript file including a reference to the ad server. See, M.P.E.P. §2143. Absent a showing of such a motivation, a prima facie case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to combine such knowledge in Landsman with HotScripts so that Applicant has the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03

Simply because information is well known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. Id. Inventions are frequently the process of combining prior art in a nonobvious manner. Id.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a

person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d

1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of Applicant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984); M.P.E.P. § 2144.04.VI.C.

The Office Action's sole justification for combining Landsman, and HotScripts is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would have rearranged the components in Landsman to reflect the arrangement of components disclosed in HotScripts, because "JavaScript is a language that was well known used [sic] to extend the capabilities of HTML." See Office Action, at 3. This assertion, however, is merely conclusory. The simple statement that the arrangement of components disclosed by HotScripts is well-known in the art does not say how or why a person of ordinary skill in the art would be motivated to modify the arrangement of Landsman in light of HotScripts.

In addition, the Office Action argues that a motivation to combine exists because one of "ordinary skill in the art would have modified Landsman to include the same reference in the referenced file downloaded from the first server since this file is needed for the system to run." See Office Action, at 8. Here, the Office Action only asserts that the the elements in Landsman can be arranged in the manner disclosed in HotScripts. It does not show why one of

ordinary skill in the art would be motivated to actually do so. That is to say, the Office Action does not explain why a person of skill in the art would not have been motivated to rearrange the elements of Landsman to reflect the arrangement shown in HotScripts.

The Office Action's assertions are general and conclusory. Simply asserting that what is taught in HotScripts is well-known to one of skill in the art, without more, does not provide the Applicant with a sufficiently clear and particular showing of a motivation to combine.

The Office Action also partakes in impermissible hindsight reconstruction to arrive at Applicant's claims. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. See Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, (Fed. Cir. 1997). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination. In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing

B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention. Ruiz v. A.B. Chance Co., 69 U.S.P.Q.2d 1686, 1690 (Fed. Cir. 2004).

The Office Action admits that hindsight reconstruction was used. The Office Action suggests no motivation to combine the references other than to derive Applicants' claims because "any [one] of ordinary skill in the art would have modified Landsman and HotScripts to derive what is claimed by Applicants." Office Action at 13. As such, no showing of obviousness has been made due to the Office Actions hindsight reconstruction of Applicants' claims.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in Landsman in light of HotScripts. As a result, the Applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness with respect to claims 1 through 15, and that the objection to those claims under §103 should be withdrawn.

Additionally, Applicant respectfully contends that, beyond the lack of a clear motivation in the cited references to combine the references, one skilled in the art would not make the two-part modification to Landsman in light of HotScripts to arrive at Applicant's claims as asserted in the Office Action. The two-part modification entails removing the link to the ad server from the ad tag and then including the link to the advertisement server in the

Javascript file.

The Landsman architecture provides for the ad server reference to be in the ad tag as opposed to being in the JavaScript file. This is not merely a trivial choice, but is a specific architectural decision. As is outlined in Landsman's disclosure, an ad tag embedded in a web page includes a URL reference to a specific ad server. In other words, a plurality of distinct ad servers and their associated URLs are available to the providers of the web pages. Therefore, the ad tag serves the function of pointing to a specific one of such ad servers.

Based on the foregoing, it is clear why Landsman does not provide the reference to the ad server in the JavaScript file. If Landsman were modified to include such reference in the JavaScript file, then a separate JavaScript file would be required for each of the plurality of ad servers. The distribution server would, in place of storing only one JavaScript file, be required to store multiple JavaScript files for each of the available ad servers. Thus Landsman provided for a single JavaScript file, and therefore provided for the reference to a specific ad server to be placed in the web page.

Simply put, one skilled in the art would not infer from Landsman's or HotScript's disclosure a motivation or suggestion to modify Landsman by placing the URL of the ad server in the JavaScript file, because such modification to Landsman would demand the addition of multiple JavaScript files for each available ad server.

In contrast, Applicants' independent claims explicitly recite a first reference in a web page to a JavaScript file and a second reference in the

JavaScript file to an ad server. This is done in lieu of referencing the ad server directly from the web page.

In view of the above, Applicants respectfully submit that Landsman and HotScripts, whether taken alone or in combination, do not render the pending claims obvious. As such, Applicant's claims are allowable over the cited references.

Applicant has responded to all of the rejections and objections recited in the Office reconsideration and Notice of Allowance for all of the pending claims is therefore respectfully requested.

If the foregoing arguments are unpersuasive in overcoming the final rejection, Applicant respectfully requests the scheduling of an interview with the undersigned.

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Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant